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MS APPEAL BRIEF - PATENTS
PATENT
0033-0693P

IN THE U.S. PATENT AND TRADEMARK OFFICE

In re application of

Before the Board of Appeals

Yoichi MIZUNO

Appeal No.:

Appl. No.: 09/784,041

Group: 1733

Filed: February 16, 2001

Examiner: J. R. Fischer

Conf.: 2528

For: CHAFER RUBBER COMPOSITION, AND HEAVY
DUTY PNEUMATIC TIRE USING THE CHAFER
RUBBER COMPOSITION

REPLY BRIEF TRANSMITTAL FORM

MS APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

May 4, 2004

Sir:

Transmitted herewith is a Reply Brief (in triplicate) on behalf of the appellants in connection with the above-identified application.

☐ The enclosed document is being transmitted via the Certificate of Mailing provisions of 37 C.F.R. § 1.8.

The Examiner's Answer was mailed on March 5, 2004.

☐ An extension of time under 37 C.F.R. § 1.136(b) to was requested on and was approved on .

☐ Please charge Deposit Account No. 02-2448 in the amount of \$0.00. A triplicate copy of this sheet is attached.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By



Andrew D. Meikle, #32,868

for

P.O. Box 747

Falls Church, VA 22040-0747

(703) 205-8000

#43,368

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Attachment(s)

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

May 4, 2004

Sir:

Pursuant to the Notice of Appeal filed on November 20, 2003, and in reply to the Examiner's Answer dated March 5, 2004, the following Reply Brief is respectfully submitted in connection with the above-identified application. The Notice of Appeal was filed in response to the final rejection of claim 2 dated June 20, 2003.

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I. Requisite Motivation and Reasonable Expectation of Success for a
Prima Facie Case of Obviousness: Muroaka '142 Cannot Be Combined
with Majumdar '940

The Examiner's Answer has not changed Applicant's position that the present invention is patentably distinct from the cited combination of references. Claim 2 was rejected under 35 U.S.C. § 103(a), in the final Office Action of June 20, 2003, as being unpatentable over Muraoka et al. (U.S. Patent No. 5,859,142, newly cited; hereinafter "Muraoka '142") in view of Majumdar et al. (U.S. Patent No. 5,503,940; hereinafter "Majumdar '940"), Matsue et al. (U.S. Patent No. 5,420,193, newly cited; hereinafter "Matsue '193") and Carter (U.S. Patent No. 5,807,918; hereinafter "Carter '918"), and this rejection concerning claim 2 is being appealed.

In repeating the outstanding rejection in the Examiner's Answer, the Examiner explains the disclosure of Muraoka '142, followed by the reasons for combining this reference with Majumdar '940 (see the Examiner's Answer starting at page 4, under "(10) Grounds of Rejection"). However, such a combination of references is still improper. The Examiner states that "While Majumdar '940 is primarily concerned with a rubber adhesive component disposed between the carcass and the tread, the reference more generally teaches the benefits of BCl when added to a tire rubber composition of natural rubber and synthetic rubber." (see page 6, lines 4-7 of the

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Examiner's Answer; Examiner's emphasis added). In this regard, Applicant maintains the position that Majumdar '940 lacks disclosure and fails to teach any benefits of BCl for a *rubber composition of a chafer*. Thus, the instant rejection is improper, and the four references have been improperly combined.

In a bead portion of a heavy duty pneumatic tire directly engaging with a rim, a chafer can be provided but will undergo repeated severe deformation and encounter highly exothermic conditions (please see Applicant's specification at page 1, lines 11-21). A chafer is shown in Figure 1 of Applicant's specification, whereby the chafer **3** extends from the bead toe portion **T** to the bead heel portion **H** of the bead portion **1**. The present invention is directed to a heavy duty pneumatic tire comprising a chafer rubber composition in the bead portion.

For this rubber composition of the chafer (as instantly claimed), rim-slippage resistance, creep resistance and toe-cracking resistance (please refer to page 1, line 15 to page 2, line 8 of Applicant's specification for such descriptions) are required features to, for example, prevent exposure of the tire reinforcing element due to abrasion of the bead portion, and to strengthen the engagement between the tire and the rim (see page 1, lines 11-14 of Applicant's specification).

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The rubber adhesive component disclosed by Majumdar '940 does not require these characteristics, nor does this reference describe a chafer to prevent exposure of the tire reinforcing element due to abrasion of the bead portion or to strengthen the engagement between the tire and the rim. Majumdar '940 does not disclose, teach or recognize the benefits of using BCl as instantly claimed in a rubber composition of the chafer. Instead, the Examiner focuses on how Majumdar '940 discloses some benefits for other compositions in attempt to account for the deficiencies of the cited primary reference of Muroaka '142.

With regard to Muroaka '142, the Examiner's reference to Muraoka '142 disclosing "high durability" and "high aging resistance" (at page 7, starting at line 7, and at page 9, lines 1-9) supports Applicant's previously stated position that one of ordinary skill in the art would recognize that Muroaka '142 achieves its goals, and thus would not be motivated to improve upon the "well-balanced" and "superior" properties of Muroaka '142 (see pages 14-16 of the Appeal Brief). This is an inconsistency yet to be addressed by the Examiner. Further, the requisite motivation and reasonable expectation success necessary to establish a *prima facie* case of obviousness has not been satisfied.

Thus, Applicant respectfully submits that the cited references of Muroaka '142, Majumdar '940, Matsue '193, and Carter '918 have

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been improperly combined as stated herein and in the previously filed Reply Brief. Reversal of the Examiner's rejection is respectfully requested.

II. Examiner's New Rejections/Issues in Examiner's Answer

With respect to the Examiner's comments at page 8, lines 8-10 of the Examiner's Answer, such comments constitute a new argument/position by the Examiner. Such comments do not appear in the Final Office Action of June 20, 2003, nor do they appear in the Advisory Action of October 1, 2003. Further, no evidence has been provided to support the Examiner's position that "[i]t is well known in the tire art industry to include additives ... properties." Instead, it appears that this assertion is based on the Examiner's personal knowledge and such an assertion constitutes new evidence relied upon to support the outstanding rejection, which Applicant submits is improper. See M.P.E.P. § 1208, 1208.01 and 37 C.F.R. § 1.193(a)(2).

Further, if the Examiner is relying upon personal knowledge to support the finding of what is known in the art, the Examiner has not provided any affidavit or declaration setting forth specific factual statements and explanations to support such an assertion as required by 37 C.F.R. § 1.104(d)(2). Further, the Examiner should have presented his personal knowledge or such an assertion in one of the earlier Office Actions instead of in an Examiner's Answer.

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The Examiner also presents new arguments/position at page 6, lines 8-13 and page 7, lines 17-22 of the Examiner's Answer. Such conclusions or assertions should have been presented earlier to Applicant in an earlier Office Action, and Applicant did not have an earlier opportunity to address such new issues/grounds of rejection.

Applicant also challenges Examiner's position that anti-reversion agents in general are conventional additives used in tire rubber compositions (see Examiner's Answer at page 5, lines 21-23). The Examiner has not provided any affidavit or declaration setting forth specific factual statements and explanations to support such an assertion as required by 37 C.F.R. § 1.104(d)(2). Still, Applicant submits that such a position is rendered moot in view of how Majumdar '940 fails to disclose any uses directed to a chafer rubber composition and is improperly combined with the other cited references.

III. Conclusion

For the reasons advanced above, and for the reasons stated in the Appeal Brief dated January 14, 2004, it is respectfully submitted that claim 2 of the present application is allowable, wherein the present invention is patentably distinct from the cited combination of references, and that these references have been improperly combined. Favorable reconsideration and reversal by the Honorable Board of Patent

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Appeals and Interferences of the Examiner's rejection under 35 U.S.C. § 103(a) of claim 2 is respectfully solicited. Applicant respectfully submits that the Final Rejection by the Examiner is without basis, and should be reversed.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 

Andrew D. Meikle

fo' Reg. No. 32,868 #43,368

P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000

ADM/ETP
0033-0693P